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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,180	09/29/2000	David Suda	192400US55X	2909
22850	7590	04/04/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			RHEE, JANE J	
			ART UNIT	PAPER NUMBER
			1745	
DATE MAILED: 04/04/2006				

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/675,180  
Filing Date: September 29, 2000  
Appellant(s): SUDA ET AL.

**MAILED**

APR 04 2006

**GROUP 1700**

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1/20/2006 appealing from the Office action mailed 4/20/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,591,521

Arakawa et al.

1-1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 19-20,32-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. (5591521).

Arakawa et al. discloses a backing sheet comprising a front side having adherent material thereon (figure 1 number 4), a back side (figure 1 number 2), a stapling tab extending along the edge of the backing sheet (figure 1 number 1), the stapling tab having a first portion of the back side positioned against a second portion of the back side, and a tacky substance bonding the first portion of the back side to the second portion of the back side (figure 1 number 7), wherein the stapling tab comprises (figure 1 number 1) first fold extending along an edge of the backing sheet, the first fold having a first portion of the front side bonded to a second portion of the front side by adherent material (figure 1 number 3 where a and b connect), and a second fold extending along the edge of the backing sheet contiguous with the first fold, the second fold having the first portion of the backside positioned against the second portion of the back side (figure 1 number 7 where b and c connect).

Arakawa et al. fail to disclose at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the

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backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side. However, Arakawa et al. teaches that it is notoriously well known in the art at the time applicant's invention was made to provide a first leg of adhesive tape to stick to a third leg of the adhesives tape with an adhesive by forming a penetrated hole at the central portion of the second leg portion (col. 1 lines 37-39).

Therefore, the second leg would have a hole that extends through the second leg such that a portion of the adherent material extends through the hole and contacts the third leg.

Thus, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Arakawa et al. with at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side in order to adhere the first leg (portion) to a third leg (portion) together as taught by Arakawa et al.'s background disclosure (col. 1 lines 37-39).

#### **(10) Response to Argument**

Appellant argues that Arakawa et al. does not teach or suggest all of the limitations recited in independent claim 19. More specifically, Appellant argues that Arawaka et al. fail to disclose a hole as recited in claim 19, wherein at least one hole that bonds the first portion of the back side to the second portion of the back side

wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole that contacts the back side.

In response to Appellant's argument above, Arakawa et al. teaches that it is notoriously well known in the art at the time applicant's invention was made to provide a first leg of adhesive tape to stick to a third leg of the adhesives tape with an adhesive by forming a penetrated hole at the central portion of the second leg portion (col. 1 lines 37-39). Therefore, the second leg would have a hole that extends through the second leg such that a portion of the adherent material extends through the hole and contacts the third leg.

Appellant further argues that Examiner expressly admits that "Arakawa et al. fail to disclose at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side".

In response to Appellant's argument, Arakawa et al.'s *present* invention discloses a Z-shaped pressure-sensitive adhesive tape composed of an (a) portion, a (b) portion, and a (c) portion, and adhesive layers formed on the inside surface of the (a) portion and the outside surface of the (c) portion and furthermore, the surface of (b) portion where the releasing treatment layer 2 does not exist is temporarily jointed to the inside surface of the (c) portion by a temporary joining means (col. 2 lines 60-col. 3 lines 6). Arakawa et al.'s *present* invention fail to disclose at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends

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through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side”.

Arakawa et al.'s *background* of the invention discloses a first leg of adhesive tape to stick to a third leg of the adhesives tape with an adhesive by forming a penetrated hole at the central portion of the second leg portion (col. 1 lines 37-39).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide, Arakawa et al. with at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side in order to adhere the first leg (portion) to a third leg (portion) together as taught by Arakawa et al.'s background disclosure (col. 1 lines 37-39).

Appellant argues that Arakawa et al. teaches away from the modification of the invention. Mores specifically, Appellant argues that Arakawa et al. discloses that there are problems that the adhesive is exuded through such a penetrated hole to make rewinding impossible and the tape become sticky to use to give an unpleasant feeling to the customer.

The rejection is based on the prior art's broad disclosure instead of its preferred embodiments. Disclosed preferred embodiments do not constitute a teaching away from a broader disclosure or a non preferred embodiments. Note Mpep 2123.

Arakawa et al. discloses the surface of (b) portion where the releasing treatment layer 2 does not exist is temporarily joined to the inside surface of the (c) portion by a

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temporary joining means (col. 3 lines 6). Arakawa et al. teaches in the background of the invention, a first leg of adhesive tape to stick to a third leg of the adhesives tape with an adhesive by forming a penetrated hole at the central portion of the second leg portion (col. 1 lines 37-39). Essentially, Arakawa et al. teaches that surface portion (b) and surface portion (c) is joined by some means of adhesive.

Arakawa et al. teaches the preferred embodiment that does not employ a hole containing penetrated adhesive to join surface portion (b) to surface portion (c), however one in the ordinary skill in the art would of found it obvious at the time appellant's invention was made to provide a hole containing penetrated adhesive to join surface portion (b) to surface portion (c) based on its broader disclosure .

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jane Rhee



Conferees:



PATRICK JOSEPH RYAN  
SUPERVISORY PATENT EXAMINER



SPE, Art Unit 1731